

REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, however, has tentatively rejected all claims 1-20. For at least the reasons set forth herein, Applicant disagrees and requests reconsideration and withdrawal of the rejections.

Discussion of Rejections under 35 U.S.C. § 102

The Office Action rejected claims 1-3, 6-7, 9-15, and 17-19 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent 6,754,266 (to Bahl). For at least the reasons set forth below, Applicants respectfully disagree and request that the rejection be withdrawn.

In applying Bahl to the claims, the Office Action has ignored certain claimed features that Bahl does not teach or disclose. Independent claim 1 recites:

1. An *apparatus* for communicating graphics between at least two remotely-located computers across a computer network *comprising:*
 - an input for receiving a video signal output from a graphics card of a source computer;*
 - a memory for storing discrete units of the video signal;*
 - a compression circuit for compressing a plurality of the discrete units into a compressed video signal;
 - a network interface circuit *coupled to both the compression circuit and the computer network*, the network interface circuit configured to format and communicate the compressed video signal over the computer network to a remote computer; and
 - an output coupled to the computer network.

(Emphasis added.)

For example, claim 1 recites: “an input for receiving a video signal output from a graphics card of a source computer.” In its application of Bahl to this element, the Office Action provides (in total) “See fig. 2, video camera, 152.” Applicants believe that the Office Action intended to cite Fig. 3 (instead of Fig. 2), as the camera 152 is illustrated in Fig. 3. Notwithstanding, the video camera 152 of Bahl is shown as outputting a video signal to a

Video Encoder 154. Therefore, Applicants assume that the Office Action is applying the Video Encoder of Bahl to be the “Apparatus” of claim 1 (as it is assumed that the Office Action is implying that the Video Encoder 154 of Bahl comprises the claimed “input for receiving a video signal” (e.g., the video signal output from the Video Camera 152)). With this application of Bahl’s Video Encoder, Bahl fails to disclose the claimed “network interface circuit” within the “apparatus,” as the Video Encoder of Bahl does not comprise a network interface. For at least this reason, the rejection is misplaced and should be withdrawn.

Further, claim 1 specifically defines the input as receiving “a video signal output from a graphics card of a source computer.” (*Emphasis added.*) The Office Action appears to have wholly ignored this emphasized claim limitation, as the video camera 152 of Bahl is not a “source computer,” nor does the video camera have a “graphics card,” as recited by claim 1. For at least this additional reason, the rejection is misplaced and should be withdrawn.

Further still, claim 1 recites “a network interface circuit **coupled to both the compression circuit and the computer network...**” In its application of Bahl to this element, the Office Action provides (in total) “See fig. 1, network interface, 23.” This is inconsistent with the previous application of Bahl to claim 1. In this regard, claim 1 defines: “... an apparatus ... comprising: in input ... a network interface circuit ...” As discussed above, the Office Action applied the Video Camera 152 against the claimed “input.” Applicants assume that the Office Action was actually applying the Video Encoder 154 (e.g. the Video Encoder having an input to receive the video signal output from the video camera), as the Video Camera does not have a input for receiving a video signal. If Applicant’s assumption is correct, then the Video Encoder 154 of Bahl (e.g., the claimed “apparatus) does

not comprise a "network interface circuit" and therefore still does not constitute a proper anticipatory reference.

Notwithstanding, the Office Action cites the "Network interface 23" as comprising the "network interface circuit" claimed in claim 1. Applicants assume that the Office Action intended to cite reference numeral "53" instead of "23," as reference numeral 53 designates the network interface. This rejection, nevertheless, is misplaced. First, the "Network Interface" of Bahl is not a part of the Video Encoder 154, which the Office Action has cited as comprising the claimed "apparatus." Further, claim 1 specifically defines the network interface circuit as being *"coupled to both the compression circuit and the computer network."* The Network Interface 53 of Bahl is not coupled to the compression circuit in this way (the Office Action applied the Video Encoder 154 as containing the compression circuit). Therefore, for at least this additional reason, the rejection of claim 1 is misplaced and should be withdrawn.

Further still, claim 1 recites a "memory for storing discrete units of the video signal." The Office Action merely cited a hard disk drive 27 of Bahl as allegedly disclosing this claimed element. Applicants respectfully disagree. First, there is no teaching or disclosure in Bahl of the hard disk drive 27 storing discrete units of the video signal (output from the video camera 152). For at least this reason, the application of Bahl is misplaced. In addition, claim 1 defines the "memory" to be a part of the claimed "apparatus." As noted above in connection with the claimed "network interface circuit," the Office Action applied the Video Encoder 154 of Bahl as being the claimed "apparatus." The hard disk drive of Bahl, however, is not a part of the Video Encoder (i.e., the Video Encoder 154 does not comprise the hard drive). For at least this additional reason, the application of Bahl against claim 1 is misplaced and should be withdrawn.

The Office Action also rejected independent claim 2 as allegedly anticipated by U.S. Patent 6,754,266 (to Bahl). For at least the reasons set forth below, Applicants respectfully disagree and request that the rejection be withdrawn.

In applying Bahl to the claims, the Office Action has ignored certain claimed features that Bahl does not teach or disclose. For example, independent claim 2 recites:

2. An **apparatus** for communicating graphics across a computer network **comprising:**
 an input for receiving a video signal;
 a memory for storing discrete units of the video signal;
 a compression circuit for compressing a plurality of the discrete units into a compressed video signal; and
 a network interface circuit ***coupled to both the compression circuit and the computer network***, the network interface circuit configured to format and communicate the compressed video signal over the computer network to a remote computer.

(Emphasis added.)

Although claims 1 and 2 have differing scope, claim 2 includes some of the same features that were emphasized in connection with claim 1, and therefore claim 2 defines over Bahl for at least the same reasons set forth above in connection with the same features of claim 1.

Claims 3-14 each depend from claim 2, and therefore each define over Bahl for at least the same reasons as claim 2. For at least these reasons, Applicants request that the rejections of claims 3-14 be withdrawn.

With regard to claim 15 (also rejected as allegedly anticipated by Bahl), claim 15 recites:

15. An **apparatus** for communicating graphics across a computer network **comprising:**

an input for receiving a video signal; and
a network interface circuit *coupled to both the input and the computer network*, the network interface circuit configured to format and communicate the video signal over the computer network to a remote computer.

(*Emphasis added.*)

Independent claim 15 includes some of the distinguishing features that were described above in connection with claim 1, and therefore claim 15 defines over Bahl for at least the same (corresponding) reasons. For example, claim 15 defines an “apparatus ... comprising: an input for receiving a video signal...” As described in connection with claim 1, the Office Action has cited the Video Encoder 154 of Bahl as comprising the “apparatus.” However, the Video Encoder 154 of Bahl does not comprise a network interface circuit, as defined by claim 15 (much less a network interface circuit couple to both the input and the computer network). For at least this reason, the rejection of claim 15 is misplaced and should be withdrawn.

Dependent claims 16-18 each depend from claim 15 and patently define over Bahl for at least the same reasons.

With regard to claim 19, claim 19 (as amended) recites:

19. A method for communicating graphics across a computer network comprising:
receiving a video signal from a graphics card of a source computer;
converting the video signal into a format suitable for communication over a computer network; and
communicating the converted video signal across the computer network to a remote computer.

(*Emphasis added.*)

Among other distinctions, the method of claim 19 (as amended) calls for *receiving a video signal from a graphics card of a source computer*. Simply stated, Bahl fails to teach or disclose such a step. The Office Action cites col. 5, lines 46-55 of Bahl of disclosing all

features of claim 19. As discussed above, Bahl disclosed a Video Encoder 154 receiving a video signal that is output from a Video Camera 152. However, claim 19, as amended, specifically claims receiving a video signal output from a graphics card of a computer. This feature, among others, clearly defines over the teachings of Bahl, and for at least this reason the rejection should be withdrawn.

Claim 20 depends from claim 19 and therefore patently defines over the cited art for at least the same reasons.

Additional Discussion of Claim 12

The Office Action rejected claim 12 as allegedly anticipated by Bahl. However, the Office Action failed to provide any separate or independent discussion of claim 12. Claim 12 recites:

12. The apparatus of claim 2, ***further comprising a plurality of network interface circuits, each network interface circuit being coupled to both a compression circuit and the computer network***, each network interface circuit being configured to format and communicate the compressed video signal over the computer network to a remote computer.

(*Emphasis added.*) Simply stated, Bahl fails to disclose the additional claimed feature of a “plurality of network interface circuits.” To assist the Examiner, the Examiner may wish to refer to FIGs. 4 and 5 of the present application, which disclose an embodiment of an apparatus (ref. num. 200) covered by claim 12. For at least this additional reason (that claim 12 defines additional features not disclosed by Bahl), claim 12 defines over the cited art.

Discussion of Rejections Under 35 U.S.C. § 103(a)

Finally, the Office Action rejected claims 4-5, 8, 16, and 20 under 35 U.S.C. § 103(a) as allegedly obvious over the combination of Bahl and U.S. Patent 6,557,031 (to Mimura). Applicants disagree and respectfully request that these rejections be withdrawn.

On a substantive basis, these claims depend from independent claims that were discussed above, and these dependent claims patently define over the cited art for at least the same substantive reasons as the independent claims from which they depend. In addition, Applicants also traverse the rejection on the basis that the combination of Mimura with Bahl is improper.

In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting

from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991).

Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create an apparatus for communicating video information over a computer network, as defined by the pending claims.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another

reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). The Office Action has failed to cite any apparent disadvantage of Bahl, which would prompt the combination of select teachings of Mimura therewith.

In fact, the rationale advanced by the Office Action for combining Mimura with Bahl was that doing so would allegedly "provide the transmission/reception video in a broadcasting system utilizing the Internet irrespective of the data format of the packet," and that the "modification would be further advantageous by improving the packet forming and conversion method thus providing high-speed, low-cost processing of packets in MPEG and IP networks." The mere fact that a combination of particular references would result in some articulated advantage is not sufficient to warrant their combination (indeed, such a rationale would permit the combination of virtually any references). Instead, there must be a meaningful reason or motivation for combining the references, with such motivation being found in the references themselves (and without the benefit of hindsight). In the present situation, the Office Action has failed to identify such a motivation.

Therefore, for at least this additional reason, Applicants submit that the rejections of claims 4-5, 8, 16, and 20 are misplaced and should be withdrawn.

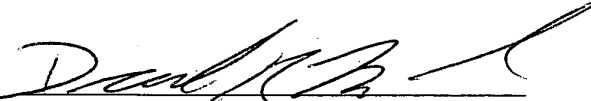
CONCLUSION

Applicant respectfully submits that all claims are now in proper condition for allowance, and respectfully request that the Examiner pass this case to issuance. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this Amendment and Response to Office Action. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to Hewlett-Packard Company's Deposit Account No. 08-2025.

Respectfully submitted,

By:



Daniel R. McClure
Registration No. 38,962

770-933-9500

Please continue to send all future correspondence to:

Hewlett-Packard Development Company, L.P.
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400